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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/115,764

07/15/98

REASONER

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65.748-449

PM82/0816

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EXAMINER

LUONG, V

ART UNIT

PAPER NUMBER

3682

DATE MAILED:

08/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/115,764

Applicant(s)

REASONER

Examiner

Vinh Luong

Group Art Unit

3682



☒ Responsive to communication(s) filed on 6/7/99 and 7/13/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as: (a) the overall length of the first and second conduit sections, and the shortening of the overall length of the first and second conduit sections in claims 1 and 17-19; and (b) the *shortest* overall length of the conduit in claim 15 must be shown, *or the features canceled from the claims. No new matter should be entered.*

Note that Figs. 1, 3 and 4 merely show portions of the first and second conduit sections 14 and 16, not their overall length. The shortening and the shortest overall lengths of the conduit sections are required to be shown in accordance with 37 C.F.R. 1.84(h), *or the features canceled from the claims.*

2. The information disclosure statement filed July 13, 1999 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (EPO # 0517583). It has been placed in the application file, but the information referred to therein (EPO # 0517583) has not been considered.

3. The Amendment filed on June 7, 1999 (Paper No. 5) has been entered.

4. The First Supplemental Reissue Declaration filed on June 7, 1999 and July 13, 1999 have been disapproved since these Declarations were not signed and dated.

5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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6. Claims 1-19 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

7. Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

8. The patent sought to be reissued by this application is involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

9. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,653,148, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

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10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-4, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Teichert (U.S. Patent No. 5,339,783).

Regarding claim 1, Teichert teaches a remote control assembly comprising:

first and second conduit sections 36 and 58 (Fig. 3);

a flexible motion transmitting core element 12 movably supported in the sections 36 and 58;

adjustment components 40 and 42 interconnecting the sections 36 and 58 and in telescoping relationship with each other for adjusting the overall length of the sections 36 and 58; and

a coil spring 38 interacting between the components 40 and 42 to bias the components 40 and 42 together to shorten the overall length of the sections 36 and 58. See Exhibit attached.

Regarding claim 2, Teichert's assembly includes a retainer 52 for retaining the spring 38. *Ibid.*, column 4, line 49 *et seq.*

Regarding claim 3, see an abutment 46.

Regarding claim 4, see female and male members 42 and 40 wherein the spring 38 is supported by the male member 40.

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Regarding claim 17, as the spring 38 is compressed axially (Fig. 2B), the first conduit 36 is pulled and the second conduit 58 (i.e., the fitting 54) moves away, consequently, the overall length of the conduit sections 36 and 58 are inherently lengthened. See lines 18-30 of column 7. Further, as the spring 38 is expanded axially (Fig. 2A), the first conduit 36 is retracted backwardly and the second conduit 58 (i.e., the fitting 54) moves forwardly until the fitting 54 is stopped by the pivot coupling 22, consequently, the overall length of the conduit sections 36 and 58 are inherently shortened. See lines 47-53 of column 7 and the Exhibit attached. It is well settled that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 U.S.P.Q.2d 1429 (CAFC 1997).

12. Claims 1-5 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Glover et al. (U.S. Patent No. 4,598,809 cited by applicant).

Regarding claim 1, Glover teaches a remote control assembly comprising:

first and second conduit sections 7 and 9;

a flexible motion transmitting core element 3 movably supported in the sections 7 and 9;

adjustment components 5 and 20 interconnecting the sections 7 and 9 and in telescoping relationship with each other for adjusting the overall length of the sections 7 and 9; and

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a coil spring 35 interacting between the components 5 and 20 to bias the components 5 and 20 together to shorten the overall length of the sections 7 and 9 as seen in Figs. 3 and 4. *Ibid.*, column 4, line 16 *et seq.*

Regarding claim 2, Glover's assembly includes a retainer 36 for retaining the spring 35.

Regarding claim 3, see an abutment 31.

Regarding claim 4, see female and male members 5 and 20. The spring 35 is supported by the male member 20.

Regarding claim 5, the male member 20 includes adjustment teeth 21 there along, and a locking member 31 supported by the female member 5 for engaging the teeth 21 in a locked position (Fig. 3) to prevent relative telescoping movement, the abutment 31 being presented by the locking member 31.

Regarding claim 17, as the spring 35 is expanded axially as seen in Fig. 3, the components 5 and 20 are biased together to shorten the length of the first conduit 7, consequently, the overall length of the first and second conduit sections 7 and 9 are shortened as explicitly described in 13-33 of column 4. It is well settled that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber, supra.*

Regarding claim 18, Glover teaches a remote control assembly comprising:

first and second conduit sections 7 and 9;

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a flexible motion transmitting core element 3 movably supported in the sections 7 and 9;

adjustment components 5 and 20 interconnecting the sections 7 and 9 and in telescoping relationship with each other for adjusting the overall length of the sections 7 and 9; wherein one (20) of the adjustment components 20 and 5 includes adjustment teeth 21 and the other (5) of the adjustment components supports a locking member 31 that selectively engages the teeth 21; and

a coil spring 35 interacting between the components 5 and 20 to bias the components 5 and 20 together to shorten the overall length of the sections 7 and 9 as seen in Figs. 3 and 4. *Ibid.*, column 4, line 16 *et seq.*

Regarding claim 19, Glover teaches a remote control assembly comprising:

first and second conduit sections 7 and 9;

a flexible motion transmitting core element 3 movably supported in the sections 7 and 9;

adjustment components 5 and 20 interconnecting the sections 7 and 9 and in telescoping relationship with each other for adjusting the overall length of the sections 7 and 9;

a coil spring 35 interacting between the components 5 and 20 to bias the components 5 and 20 together to shorten the overall length of the sections 7 and 9; and

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a collar 37 (Fig. 3) supported on one (20) of the adjustment components 5 and 20 for reacting axially between the one of the components and the spring 35.

13. Claims 6-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

15. Applicant's arguments filed June 7, 1999 (Paper No. 5) have been fully considered but they are not persuasive.

DECLARATION

Applicant admitted in the "REMARKS" of Paper No. 5 that the Supplemental Declaration was unsigned, *a fortiori*, it has been disapproved. See M.P.E.P. 402 and 502.02.

ART REJECTION

First, applicant contended, *inter alia*, that what the examiner calls a "conduit section" is actually a fitting 54, 56, 58, which is fixed to the cable 12 for movement therewith as described in lines 60-68 of column 5 of Teichert.

The examiner respectfully submits that applicant wrongly uses "*ipsissimis verbis*" test that requires the same terminology in the prior art in order to find anticipation. See *AKZO N.V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1245 (CAFC 1986)(foot note

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11). It is well-settled law that an applicant is ordinarily permitted to use his or her own terminology as long as it can be understood. M.P.E.P. 608.01(g). In fact, the CAFC in *Fromson v. Advance Offset Plate, Inc.*, 219 U.S.P.Q. 1137, 1140 (CAFC 1983) has long laid applicant's semantic arguments to rest by pointing out that:

"The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words but words for things. To overcome this lag, patent law allows the inventor to be his own lexicographer."

It is noteworthy to be aware of the fact that in U.S. Patent No. 5,178,034, the same applicant of this application, Reasoner, used the terms "first (18) and second (20) conduit sections" to indicate the elements which are the so-called "adjustment components" in this application. In the case at hand, since Teichert is entitled to his own lexicography in the same manner as the instant applicant, the fitting 54, 56, 58 of Teichert based on Teichert's terminology can be reasonably understood or interpreted as the second conduit section using applicant's terminology in applicant's claims.

Second, applicant asserted that the spring 38 does not interact between the spring guides 40 and 42 to bias the guides together to shorten the length. However, the examiner respectfully submits that this argument is transparently in direct conflict with the evidence presented in the patent issued to Teichert. Contrary to applicant's remarks:

(a) Fig. 2B shows that as the spring 38 is compressed axially, the first conduit 36 is pulled and the second conduit 58 (i.e., the fitting 54) moves away, consequently, the

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overall length of the conduit sections 36 and 58 are lengthened. See lines 18-30 of column 7; and

(b) Fig. 2B shows that as the spring 38 is expanded axially, the first conduit 36 is retracted backwardly and the second conduit 58 (i.e., the fitting 54) moves forwardly until the fitting 54 is stopped by the pivot coupling 22, consequently, the overall length of the conduit sections 36 and 58 are shortened. See lines 47-53 of column 7.

For applicant's convenience, the examiner attached the Exhibit wherein L1 is the overall length of the first and second conduit sections 36 and 58 when the spring is expanded (Fig. 2A), and L2 is the overall length of the first and second conduit sections 36 and 58 when the spring is compressed (Fig. 2B). Applicant is respectfully advised to use a ruler and measure the lengths of L1 and L2. Applicant would recognize that L1 is shorter than L2. It has long been settled law that a claimed invention may be anticipated or rendered obvious by a drawing in a reference, whether the drawing disclosure is accidental or intentional. *In re Meng*, 181 U.S.P.Q. 94, 97 (CCPA 1974) and *In re Mraz*, 173 U.S.P.Q. 25 (CCPA 1972). On the other hand, the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber, supra*.

For the reasons stated above, the previous art rejection is maintained.

16. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-7687. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and

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delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tamara Graysay, can be reached on (703) 306-4601. The fax phone number for this Group is (703) 308-2144. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong
April 16, 1999



Vinh T. Luong
Primary Examiner

FIG. 4

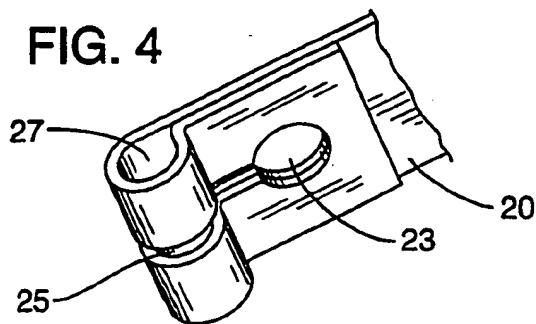


FIG. 2A

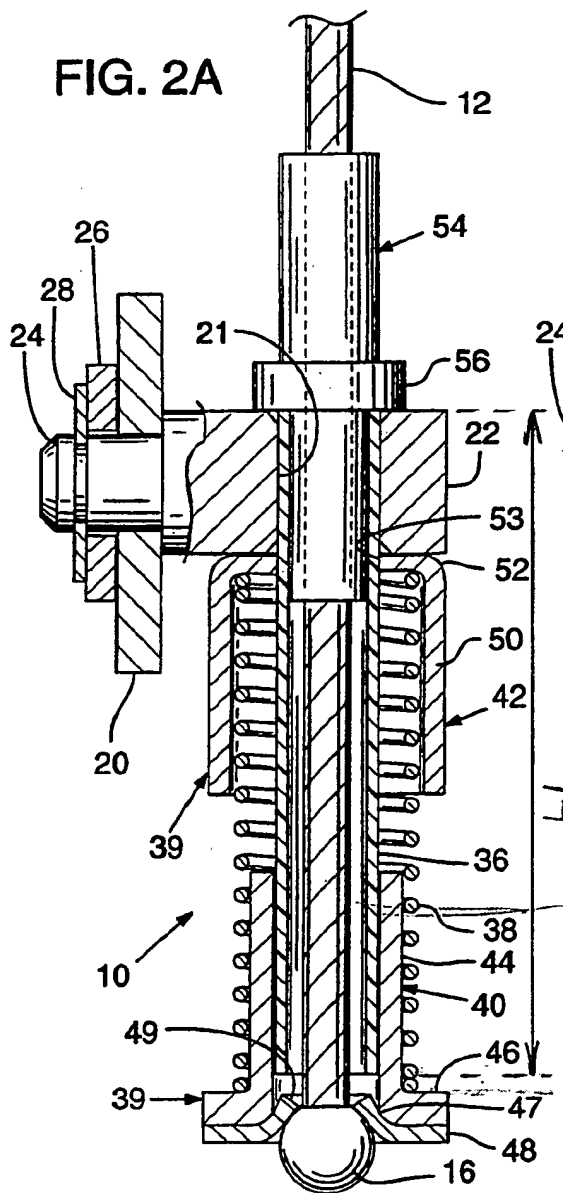
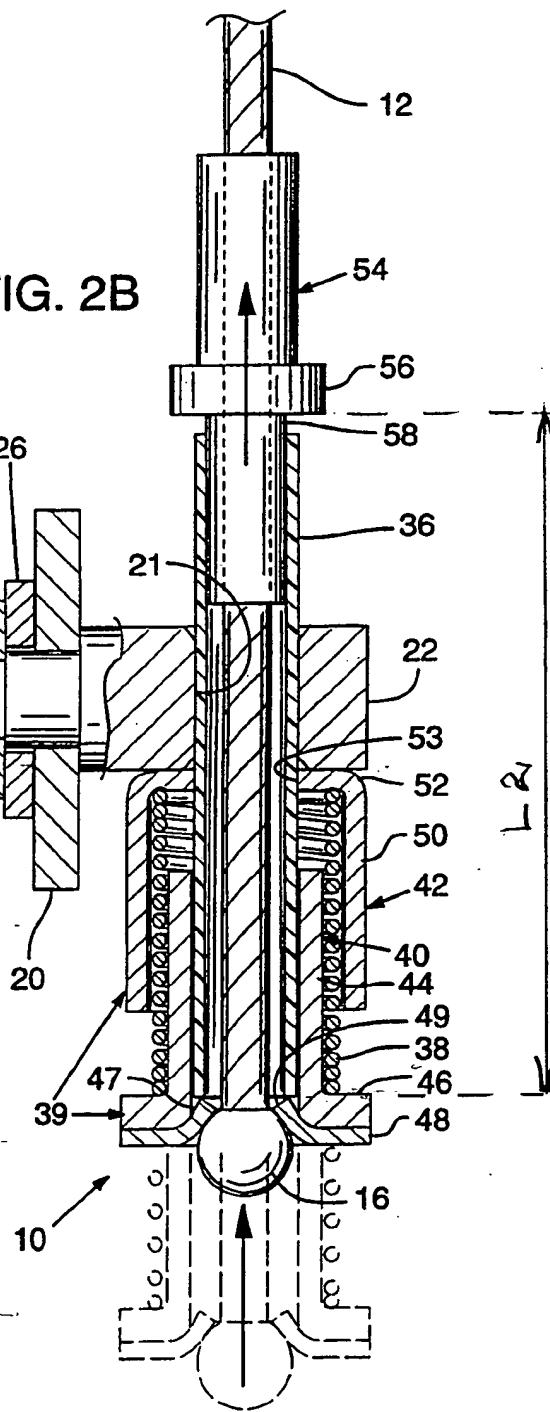


FIG. 2B



NOTE THAT L1 IS SHORTER THAN L2 AS MEASURED BY A RULER
EXHIBIT